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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.        | CONFIRMATION NO.       |
|--|-------------|----------------------|----------------------------|------------------------|
| 10/775,821   | 02/10/2004  | Hiroyasu Kurashina   | 81752.0154                 | 8188                   |
| 26021 7590 12/10/2007<br>HOGAN & HARTSON L.L.P.<br>1999 AVENUE OF THE STARS<br>SUITE 1400<br>LOS ANGELES, CA 90067 |             |                      | EXAMINER<br>ZHENG, JACKY X |                        |
|  |             |                      | ART UNIT<br>2625           | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>12/10/2007    | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/775,821

Applicant(s)

KURASHINA, HIROYASU

Examiner

Jacky X. Zheng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on February 10, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on February 10, 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5/30/2006.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

1. This is the initial office action based on the application filed on February 10, 2004.

#### *Priority*

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### *Information Disclosure Statement*

3. The information disclosure statement (IDS) submitted on May 30, 2006 was filed after the mailing date of the application on February 10, 2004. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

#### *Claim Rejections - 35 USC § 101*

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 9-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claim is drawn to “a program” per se, which can be characterized as either “functional descriptive material” or “nonfunctional descriptive material”. As functional descriptive material when “consists of data structures and computer programs which impart functionality when employed as a computer component”; and as non-functional descriptive material if it “includes but is not limited to music, literary works and compilation or mere arrangement of data” (See “Interim Guideline for Examination of Patent Application for Patent

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*Subject Matter Eligibility*", ANNEX IV, Page 50). The claims are being considered as functional descriptive materials in this case. However, "both types of "descriptive material" are nonstatutory when claimed as descriptive material per se".

In addition, even considering the claim as "functional descriptive material" imparts with functionality, but not being employed as a computer component (or other physical structures), is considered as non-statutory. "In contrast, a claimed **computer-readable medium encoded with a computer program... is thus statutory.**" (See "*Interim Guideline for Examination of Patent Application for Patent Subject Matter Eligibility*", ANNEX IV, Page 53, First Paragraph;).

Therefore, these two types of "descriptive material" are nonstatutory when claimed as descriptive material per se (See "*Interim Guideline for Examination of Patent Application for Patent Subject Matter Eligibility*", ANNEX IV, Page 50, Second Paragraph; & ANNEX I, Page 30;).

These issues also affect the dependent claims 11 and 12, thus claims 9-12 are rejected under 35 U.S.C. 101.

6. Claims 9-12 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966) (also see the rejections under 35 USC § 112 below).

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***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claims 9 and 10 recite the limitations of “for causing to function ...” and “for executing the method ...” respectively, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

10. Claims 11 and 12 both recite the limitation of “for storing the program according to”, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

11. Claims 1, 6 and 8 recite the limitations of “tentative option”, “determinate option”. Such a limitation has not been *explicitly* depicted with sufficient descriptions in the instant claim. The scope of such a limitation is unable to be determined, which renders the claim scope indefinite. These issues also affect the dependent claims.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. **Claims 1-4, 6 and 8-12** are rejected under 35 U.S.C. 102(b) as being anticipated by

**Makino et al. (U.S. Patent No. 5,388,251)**

**With regard to claim 1**, the claim is drawn to a printing apparatus (*see Makino et al., i.e. Figure 1*) having: display means capable of option display in which a plurality of options related to printing are displayed on a display screen (*see Makino et al., i.e. Figure 1, Part 11 and Figure 2*); tentative option designating means for designating at least one arbitrary option out of the plurality of options as a tentative option on the display screen (*see Makino et al., i.e. Figure 1, Part 10, specifically column 4, line 24, "function keys", such as: Up, Down, Left and Right keys*); selection determination means for determining the tentative option as a determinate option (*see Makino et al., i.e. Figure 1, Part 10, i.e. "Enter/Return key"*); and print means for printing based on the determinate option (*see Makino et al., i.e. Figure 1, Part 12*), wherein said printing apparatus comprises: explanation requesting means capable of requesting, before the determination, a handling explanation including at least one of an operating explanation for guiding a next operation from a state of the option display and a function explanation for explaining a function of the tentative option (*see Makino et al., i.e. Figure 1, Part 13, "Help Key"*); and display switching means (*see Makino et al., i.e. Figure 2, Part 21 "Buffer Switching*

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Unit”) for switching, when the handling explanation is requested, display of the display screen from the option display to explanation display that is display of the handling explanation.

**With regard to claim 2**, the claim is drawn to the printing apparatus according to claim 1, wherein: a plurality of display modes are defined inclusive of an option display mode for commanding the option display (see *Makino et al.*, i.e. Figures 2, 3A) and an explanation display mode for commanding the explanation display; said explanation requesting means requests the handling explanation by switching from the option display mode to the explanation display mode (see *Makino et al.*, i.e. Figure 2); and said display switching means allows the display screen to perform the option display in the option display mode and the display of the handling explanation in the explanation display mode (see *Makino et al.*, i.e. Figure 2).

**With regard to claim 3**, the claim is drawn to the printing apparatus according to claim 2, wherein said explanation requesting means is key operation means for alternately switching between the option display mode and the explanation display mode by operating an identical key (see *Makino et al.*, i.e. Figure 1, Part 13 “Help Key”).

**With regard to claim 4**, the claim is drawn to the printing apparatus according to claim 1, further comprising: explanation printing commanding means for commanding explanation printing in which the handling explanation is printed by said print means before the determination (see *Makino et al.*, i.e. Figure 1, Part 13 “Help Key”, serves as “explanation printing commanding means” to commanding “the explanations” to be printed onto the display screen within the printer);.

**With regard to claim 6**, the claim is drawn to a printing apparatus (see *Makino et al.*, i.e. Figure 1) having: display means capable of option display in which a plurality of options related

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to printing are displayed on a display screen (*see Makino et al.*, i.e. Figure 1, Part 11); tentative option designating means for designating at least one arbitrary option out of the plurality of options as a tentative option on the display screen (*see Makino et al.*, i.e. Figure 1, Part 10, column 4, line 24, "function keys", such as: Up, Down, Left and Right keys); selection determination means for determining the tentative option as a determinate option (*see Makino et al.*, i.e. Figure 1, Part 10, such as "Enter/Return Key"); and print means for printing based on the determinate option *see Makino et al.*, i.e. Figure 1, Part 12), wherein said printing apparatus comprises: explanation requesting means capable of requesting, before the determination, a handling explanation including at least one of an operating explanation for guiding a next operation from a state of the option display and a function explanation for explaining a function of the tentative option (*see Makino et al.*, i.e. Figure 2); and explanation printing commanding means for commanding explanation printing in which the handling explanation is printed by said print means when the handling explanation is requested (*see Makino et al.*, i.e. Figure 1, Part 13 "Help Key", serves as "explanation printing commanding means" to commanding "the explanations" to be printed onto the display screen within the printer).

**With regard to claim 8**, the claim is drawn to a method of displaying explanations of a printing apparatus which displays a plurality of options related to printing on a display screen, specifies at least one arbitrary option as a tentative option, determines the tentative option as a determinate option, and performs printing based on the determinate option, said method comprising: an explanation requesting step capable of requesting, before the determination, a handling explanation including at least one of an operating-explanation for guiding a next operation from a state of option display, in which the plurality of options are displayed, and a



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function explanation for a function of the tentative option; and an explanation executing step of executing one of a display switching step of switching display of the display screen from the option display to display of the handling explanation when the handling explanation is requested, and an explanation printing step of printing the handling explanation on an object to be printed (*The claim is rejected under the same ground for at least the reasons set forth above. See the detailed discussion of the claims 1 and 6 above.*)

**With regard to claim 9**, the claim is drawn to a program for causing to function each of said means of said printing apparatus according to any one of claims 1 to 7 (*see Makino et al., i.e. column 4, lines 1-8, disclose the implementation of a "control program" to be stored on a ROM, to be processed by a microcomputer.*)

**With regard to claim 10**, the claim is drawn to a program for executing the method of displaying explanations of the printing apparatus according to claim 8 (*see Makino et al., i.e. column 4, lines 1-8, disclose the implementation of a "control program" to be stored on a ROM, to be processed by a microcomputer.*)

**With regard to claim 11**, the claim is drawn to a storage medium for storing the program according to claim 9 so as to be readable by a printing apparatus which is capable of program processing (*see Makino et al., i.e. column 4, lines 1-8, disclose the implementation of a "control program" to be stored on a ROM, to be processed by a microcomputer.*)

**With regard to claim 12**, the claim is drawn to a storage medium for storing the program according to claim 10 so as to be readable by the printing apparatus which is capable of program processing (*see Makino et al., i.e. column 4, lines 1-8, disclose the implementation of a "control program" to be stored on a ROM, to be processed by a microcomputer.*)

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***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. **Claims 5 and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Makino et al. (U.S. Patent No. 5,388,251)** (and *alternatively* over **Hastings et al. (U.S. Patent No. 5,885,012)**).

**With regard to claim 5**, the claim is drawn to the printing apparatus according to claim 4, wherein an object to be printed in the explanation printing is one which can be attached to an object of attachment through an adhesive surface.

**With regard to claim 7**, the claim is drawn to the printing apparatus according to claim 6, wherein an object to be printed in the explanation printing is one which can be attached to an object of attachment through an adhesive surface.

Makino et al. does not *explicitly* disclose in words that "an object" to be printed "can be attached to an object of attachment through an adhesive surface". However, Examiner is herein taking an official notice that such claimed "object" having "an adhesive surface" is well-known in the field of label printing and/or general printing. Providing a few instances here for purpose of discussion (but not limited to the ones listed below in view of claim scope), such as: label sheets with adhesive surface, adhesive tape cassette/cartridge, sticker paper, Post-It<sup>®</sup> Notes, and etc.

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In addition, for purpose of advancing the prosecution, prior art, Hastings et al. is also cited for the record for illustrating the printing substrate or medium with adhesive property is well-known, and disclosure of adhesive tape is provided in Hastings et al.

### *Conclusion*

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- A. Stadler (U.S. Patent No. 4,899,276) discloses a field-directed screen help technique.
- B. Hayama (U.S. Patent No. 6,115,024, Seiko Epson) discloses a display device, switched between a text displaying an image of a character string corresponding to text data on a display screen thereof and an image display mode for displaying an image corresponding to image data on the displaying screen.
- C. Sakai et al. (U.S. Pub. No. 2005/0057761, Seiko Epson) disclose a tape printing system, method of data processing in printing system, program and memory medium.
- D. Miyasaka (U.S. Pub. No. 2005/0007606 A1, Seiko Epson) discloses a printing apparatus, a display method of the printing apparatus and etc.
- E. Kurashina (U.S. Pub. No. 2003/0218773, Seiko Epson) discloses a method of processing character in tape printer as well as tape printer.
- F. Sakuragi et al. (U.S. Patent No. 5,609,424) disclose a tape-shaped label producing device having input instructing messages.
- G. Hayama et al. (U.S. Patent No. 6,384,922, Seiko Epson) discloses a tape printer.
- H. Nunokawa et al. (U.S. Patent No. 6,092,947, Seiko Epson) disclose a tape printing device.

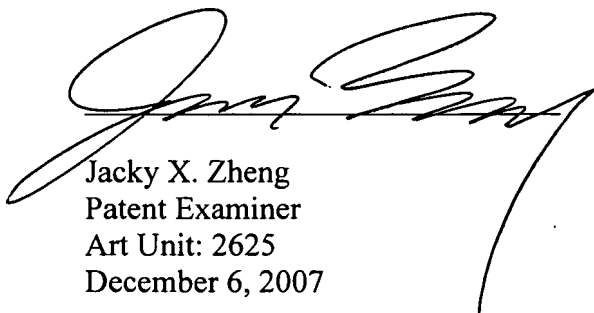
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- I. Nunokawa et al. (U.S. Patent No. 5,651,619, Seiko Epson), disclose a tape printing device with display.

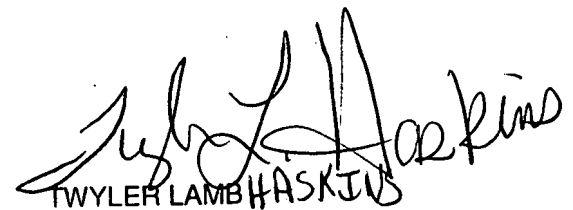
17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacky X. Zheng whose telephone number is (571) 270-1122. The examiner can *normally* be reached on Monday-Friday, 8:30 a.m. - 5 p.m., Alt. Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached on (571) 272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jacky X. Zheng  
Patent Examiner  
Art Unit: 2625  
December 6, 2007



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